

REMARKS

With entry of this amendment, claim 137 has been cancelled. As a result, claims 1-9, 18-23, 37-47, 126-136, and 138-177 remain pending in this application. Based on the foregoing amendments and following remarks, reconsideration and allowance of this application is respectfully requested.

Claim Objections

Claims 8, 9, 18, and 19 stand objected to because claims 8, 9, 18, and 19 improperly depend from "claim 0." In response to this informality, claims 8, 9, 18, and 19 have been amended to depend from claim 1. As such, Applicant respectfully requests withdrawal of these claim objections.

Claim Rejections-35 U.S.C. §102

Claims 1, 2, 4-10, 18, and 19 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 7,072,719 ("Vinup"). Applicant respectfully traverses this rejection, since Vinup does not disclose each and every element required by these claims.

In particular, in response to Applicant's argument that Vinup does not disclose that the first lead body 23 is longer than the second lead body 26, the Examiner stated that "the illustration provides ample suggestion that it is certainly possible for one lead to be longer than the second lead; the illustration itself shows this." Applicant disagrees.

Figs. 2-5 merely show that the distal end of the first elongated body 23 extends distally to the distal end of the second elongated body 26. What Figs. 2-5 do not show are the proximal ends of the respective leads. For example, there is no reason that the lead bodies illustrated in Figs. 2-5 can have the same lengths, such that second elongated body

26 is simply offset from the first elongated body 23 (i.e., the distal end of the first elongated body 23 extends distal to the distal end of the second elongated body 26, while the proximal end of the second elongated body 26 extends proximal to the proximal end of the first elongated body 23). In fact, making the lead bodies the same length would seem to be the conventional way of doing things, and the Examiner has not shown otherwise.

Significantly, the fact that "it is certainly possible for one lead to be longer than the second lead" is completely irrelevant to the determination of whether Vinup expressly or inherently discloses that the first elongated body 23 is longer than the second elongated body 26. The Examiner should note the following:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

* * *

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. (See MPEP §2112) (emphasis in original).

Thus, to establish a prima facie case of anticipation, it is the Examiner's obligation to show why the elongated lead bodies illustrated in Figs. 2-5 of Vinup necessarily have different lengths—not Applicant's obligation to show why this is not possible. Indeed, the Applicant has set forth an exemplary and conventional embodiment where the lead bodies have the same lengths despite the fact that the distal end of one of the lead bodies distally extends beyond the distal end of the other lead body.

Furthermore, the Examiner concluded that Vinup discloses that the proximal ends of the lead bodies 24, 26 extend from the lower end of the patient's back. This may be true, but claim 1 does not require this. Instead, claim 1 requires that the second elongated body be shorter than the first elongated body, such that:

a proximal end of the first elongated body is configured for extending from an opening in the patient's back to a location external to the patient when a distal end of the first elongated body is disposed within the patient's spine, and the second elongated body is configured for being entirely received within the patient's spine when the complementary coupling mechanism is slidably and completely engaged with the coupling mechanism when the proximal end of the first elongated body extends from the opening in the patient's back.

Thus, as stated in the previous response, there is no express or inherent disclosure in Vinup that the proximal end of the first elongated body 23 extends from an opening in the patient's back when the coupling mechanisms are completely engaged with each other, and when the second elongated bodies 26 are entirely disposed within the patient's spine. In fact, Fig. 1 illustrates that the only way that the proximal end of the first elongated body 23 extends from the patient's back is when the proximal ends the second elongated bodies 26 also extend from the patient's back.

Thus, Applicant submits that independent claim 1, as well as the claims depending therefrom (claims 2, 4-10, 18, and 19), are not anticipated by Vinup, and as such, respectfully request withdrawal of the §102 rejection of these claims.

Claim Rejections-35 U.S.C. §103

Vinup and Cross

Claims 3, 20-23, and 37-47 stand rejected under 35 U.S.C. §103, as being obvious over Vinup in view of U.S. Patent No. 6,578,733 ("Cross"). Applicant respectfully traverses

this rejection, since no proper combination of Vinup and Cross discloses, teaches, or suggests the combination of elements required by these claims.

Claims 3 and 20-23

As discussed above, and as required by independent claim 1 from which these claims depend, Vinup does not disclose, teach, or suggest having a second stimulation lead shorter than a first stimulation, such that the proximal end of the first elongated body is configured for extending from an opening in the patient's back when the distal end of the first elongated body is disposed within the patient's spine, and the second elongated body is configured for being entirely received within the patient's spine when the complementary coupling mechanism is slidably and completely engaged with the coupling mechanism. Cross does not supplement this failed teaching.

Dependent claim 20 further requires a method that comprises delivering the second stimulation lead into the epidural space by sliding the complementary coupling mechanism along the coupling mechanism, such that the proximal end of the first elongated body extends from the opening in the patient's back, and the second elongated body is entirely received within the patient's spine. Neither Vinup nor Cross discloses this, expressly or inherently.

Thus, Applicant submits that independent claim 1, as well as the claimed depending therefrom (claims 3 and 20-23), are not obvious over any proper combination of Vinup and Cross, and as such, respectfully request withdrawal of the §103 rejections of these claims.

Claims 37-47

Independent claim 37 requires the method to deploy the second stimulation lead from the first stimulation lead. Neither Vinup nor Cross discloses deploying one lead from another lead. The Examiner should note that “under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device.” (See M.P.E.P. §2112.02)(emphasis added). Thus, even if an assembly resulting from the combination of Vinup and Cross could potentially deploy one lead from another, it would not be inherent to do so.

Thus, Applicant submits that independent claim 37, as well as the claimed depending therefrom (claims 38-47), are not obvious over Vinup, and as such, respectfully request withdrawal of the §103 rejections of these claims.

Vinup

Claims 126-145 and 162-177 stand rejected under 35 U.S.C. §103, as being obvious over Vinup. Applicant respectfully traverses this rejection, since no proper combination of Vinup discloses, teaches, or suggests the combination of elements required by these claims.

Claims 126-136 and 138-145

Independent claim 126 has been amended to include the limitations of now-cancelled dependent claim 137, which the Examiner indicated as having patentable subject matter. Thus, Applicant submits that independent claim 126, as well as the claimed depending therefrom (claims 127-136 and 138-145), are not obvious over Vinup, and as such, respectfully request withdrawal of the §103 rejections of these claims.

Claims 162-177

Independent claim 162 requires the second tissue stimulation lead to comprise “a flap on which the second stimulation element is disposed, the flap extending along a portion of the complementary coupling mechanism, and configured to be secured by the coupling mechanism when the portion of the complementary coupling mechanism slidably engages the coupling mechanism and released by the coupling mechanism when the portion of the complementary coupling mechanism slidably disengages the coupling mechanism.

In contrast, not only does Vinup fail to disclose a flap that is capable of performing this function, it does not disclose a flap at all, and the Examiner has not pointed to any disclosure in Vinup to show that it does. Thus, Applicant submits that independent claim 162, as well as the claimed depending therefrom (claims 163-177), are not obvious over Vinup, and as such, respectfully request withdrawal of the §103 rejections of these claims.

Allowable Subject Matter

Applicant graciously acknowledges the allowance of claims 146-161. In accordance with the Examiner's suggestion, the limitations of claim 137 (now-cancelled), which recites patentable subject matter, have been incorporated into independent claim 126.

Conclusion


Based on the foregoing, it is believed that all claims are now allowable and a Notice of Allowance is respectfully requested. If the Examiner has any questions or comments regarding this response, the Examiner is respectfully requested to contact the undersigned

at (949) 724-1849.

Respectfully submitted,

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Dated: July 15, 2008

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